

727105



PATENT APPLICATION TRANSMITTAL LETTER

A. J. RNEY'S DOCKET NO.

KIRK 3.0-001

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

transmitted herewith for filing is the patent application of

ANDREW VICTOR SCHALLY AND REN ZHI CAI

for BIOLOGICALLY ACTIVE OCTAPEPTIDES

Enclosed are:

- ☐ _____ sheets of drawing. ☒ Claim as small entity ☒ Independent
☐ an assignment of the invention to _____ ☐ Small Bus.
☐ a certified copy of a _____ application. ☐ Non-Profit
☐ associate power of attorney.

CLAIMS AS FILED

FOR	NUMBER FILED	NUMBER EXTRA	RATE	FEE
TOTAL CLAIMS	21 -20 =	1	\$5 X \$10 =	\$ 5.00
INDEPENDENT CLAIMS	2 - 3 =	0	\$ 15 X \$ 30 =	00
BASIC FEE \$150 /\$ 300				\$155.00
TOTAL FILING FEE				\$155.00

☐ Please charge my Deposit Account No. 02-1750 in the amount of \$ _____.

A duplicate copy of this sheet is enclosed.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment to Deposit Account No. 02-1750. A duplicate copy of this sheet is enclosed.

☒ A check in the amount of \$ 155.00 to cover the filing fee is enclosed.

23 APR 85
date

[Signature]
Attorney of Record

Omri M. Behr
Regis. No. 22,940

Telephone (201) 494-5240



PATENT APPLICATION TRANSMITTAL LETTER

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Schally et al.

Serial No. 727,105

Group Art Unit: 123

Filed: 4/25/85

Examiner: D. Phillips

FOR: BIOLOGICALLY ACTIVE OCTAPEPTIDES

April 18th, 1986
Edison, N.J. 08837

DISCUSSION OF THE PRIOR ART

Hon. Commissioner of Patents & Trademarks
Washington, D.C. 20231

Dear Sir:

Applicants have conducted a search of the art relating to the present application in the Austrian Patent Office who found a number of references, some of which are of significance and some of which are not of significance. While this paper will mention all references found, only copies of the English language counterparts are enclosed.

NON-RELEVANT PATENTS

U.S. 4,440,904 is not relevant since the present application concerns an octapeptide and the reference application concerns a nonapeptide.

U.S. patents 4,282,143 and 4,443,434 and European EP-A1-0030920 (corresponding to DDR. Patent No. 154098). These patents are not considered relevant since they relate to a situation where the terminal groups corresponding to Applicants moiety B, is other than an amino acid amide.

British Patent 2,125,799 (corresponding to French 2,532,308 and German 3,328,952) is not relevant in that the substituent corresponding to Applicants moiety A carries a phenyl alkyl group which is not carried by Applicants compounds.

RELEVANT PATENTS

The broad disclosures of U.S. patents 4,439,403 and 4,435,385 may, in a generic sense, disclose the compounds disclosed and claimed in the present application. This disclosure however, particularly with reference to moiety "E" which is equivalent to moiety "Y" in Applicants application, is so broad as to be substantially meaningless and can not constitute a teaching of Applicants invention. The Bauer patents specifically disclose, as do Applicants, the threonine moiety in this position. They do not mention valine. It is Applicants position that the broad disclosure of Bauer cannot be read as teaching valine.

A further view of the two Bauer patents discloses further similarities. The 4,435,385 patent designates the group F (Applicants group B) as having a possible value of an amide ($-\text{CO}-\text{N.R}_3.\text{R}_4$) R_3 and R_4 may be hydrogen. Applicants however require that in this position there be not only an amido group but an amino acid amide. The '385 patent does in fact disclose such a grouping. In an alternate modification the R_4 may be $-\text{CH}(\text{R}_5)\text{X}$. R_5 may, inter alia, be the substituent attaching to the alpha carbon of a natural alpha amino acid, specifically disclosed at 12.2 as being $-\text{CH}(\text{OH})\text{CH}_3$, the threonyl residue. The X group which may be an amido group must clearly be attached to the carbon of the R_4 group. Hence, '385 Bauer discloses or suggests Applicants' B group.

However, as there is no specific teaching in the references of the "E" group as valine, Applicants have restricted the claims thereto. A similar circumstance may be deduced from the '403 Bauer patent.

Hence, it is respectfully submitted that while the two Bauer patents are relevant to Applicants invention as now claimed, they in no way suggest or teach it and therefore are not available as a basis of rejection.

Respectfully submitted,



Omri M. Behr

Regis. No. 22,940

Telephone (201) 494-5240
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